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IN THE

SUPREME COURT OF THE UNITED STATES

October Term, 1958

No. 630

GEUDER, PAESCHKE & FREY CO.,
a corporation,

Defendant-Petitioner,

vs.

J. R. CLARK COMPANY, a corporation,
& JOHN R. CLARK,

Plaintiffs-Respondents.

PETITIONER'S REPLY

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PETITIONER'S REPLY

The Petition herein was based upon two grounds, neither of which is refuted or met by Respondents.

1. The interpretation of *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, by the Ninth Circuit Court of Appeals, i.e., that " * * * there must be a specific finding that the old elements which made up this device perform an additional and different function in combination, than they perform out of * * * " the claimed combination, was expressed as a positive ground for the decisions in *Kwikset Locks Inc. v. Hillgren*, 240 F. 2d 483, and *Bergman v. Aluminum Lock*

Shingle Corp. of America, 251 F. 2d 801. No such finding was made in the present case.

The pre-trial Stipulation (F. of F. 4, A. 116) limited the issue of infringement to Claim 1 and the test of validity to certain specific prior art. Validity was in issue, and if the Ninth Circuit is to be followed, the specific combination of Claim 1 as to validity would have to be measured as to the new function of its elements (not the elements of the other claims, or other elements disclosed but not included in the claim).

The several alleged advantages of the ironing table of the patent in suit as found by the trial court (F. of F. 7, 11, A. 116, 117) and as mentioned in the patent (A. 139) comprise adjustment of height for sit down and stand up ironing, rigidity, collapsibility, leg room beneath the board, automatic adjustment of height, and a detachable floor contact member. The recital of Claim 1 does not produce the said advantages by virtue of the elements combined therein, namely single bar legs pivoted at their intersection and having portions above the intersection lying adjacent to the plane of one edge of the board. More leg room may result from the offset of the legs from the center of the table, but this is not a new feature giving rise to a new function. Ironing table legs had been offset in the Mary Proctor stand-up and sit down table (A. 197) and in Lowenberg (A. 225), not an ironing table but admitted by the patentee Olander to be "in a closely related art" (A. 202), the offset was carried beyond the edge of the table and room obtained thereunder as a bedside table.

The trial court did not and could not make a finding of a new function for the elements of Claim 1. Further, Respondents' attempt to construe the findings as a com-

pliance with this Court's decision in no way negatives the conflict between the Circuits, but rather magnifies it.

2. The term "adjacent" used in Claim 1 to specify the position of the leg structure, so as to distinguish from the prior art and advise the public as to the area of monopoly, must be construed in light of both the relevance of the prior art and the patentee's representations in his specification and drawings. (This issue is not one that merely deals with validity, as Respondents treat it in their argument (page 7, para. (6), but raises the question of how the public is to determine the breadth of the claim in suit).

It is not proper to resolve the issue of validity and presence of invention by reference to patentee's table as a whole (those elements which are covered by all the Claims 1-16 and are described in the specification), and then after such determination independently to decide whether the few elements of Claim 1 may be infringed by resort to a broadening of its language. This constitutes a double standard that may save a broad or incomplete claim, and then establish infringement by a device that resembles the prior art rather than a literal reading of the claim. The application of the doctrine of equivalents in this case to broadly construe "adjacent", after first finding invention in the complete table, enables the patentee to avoid specific application of the prior art to Claim 1. As a result the public is unable to determine the manner in which it may compete. The essence of the patent system to encourage and foster disclosure of a patentee's contribution, so as to promote progress of the arts, thereby becomes emasculated.

CONCLUSION.

Respondents have not negatived the grounds for a Writ of Certiorari and such Writ should issue to review the judgment of the Court of Appeals for the Seventh Circuit in the above entitled cause.

Respectfully submitted,

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January 28, 1959

NOTICE OF SERVICE

This is to certify that five copies of this Brief have been served on Mr. Andrew E. Carlsen, counsel for Respondents, by mailing the same to him at his last known address, postage prepaid, this 28th day of January, 1959.

Maxwell H. Herriott